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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,965	06/28/2000	Yukio Tada	39303-20145.00	5999

25224 7590 06/07/2004
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EXAMINER

LAO, LUN S

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,965

Applicant(s)

TADA, YUKIO

Examiner

Lun-See Lao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Introduction

1. This action is response to the amendment filed on 03-11-2004. Claim 1 has been canceled, claims 2-6 have been amended and claims 7-26 have been added. Claims 2-26 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach "said center station is a radio station" as recited in claim 8.

In the application as filed, there does not appear to be any detailed descriptions or disclosure of the center station being a radio station. At best, applicant discloses that the center station 100 is a host computer. See page 6, line 35 – page 7, line 8.

Applicant fails to disclose "said center station is a radio station" in the specification as filed.

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4. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant recites "said center station is a radio station" in claim 8. There does not appear to be a written description of the claimed limitation in the application as filed, for the reasons set forth in the objection to the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites "said memory" in line 14. There is insufficient antecedent basis for this limitation in the claim. For the purpose of art rejection, it is interpreted as "said data memory device", as best understood and as it appears to be.

Claim Objections

7. Claim 11 is objected to because of the following informalities: A "\ " is appended to the end of line 4. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-7, 9-17, 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over author admitted prior art (page 1, line 10 - page 3, line 14, fig. 4, hereafter APA) in view of Tsurumi et al (US Pat. 5,890,910).

Regarding claim 26, APA teaches (page 1, line 10 – page 3, line 6, fig. 4) a download system for downloading music data sets (music data, page 1, lines 10-14), a download apparatus comprising:

a player (portable player) including a storage medium (EEP-ROM) for storing music data (store music data) (page 1, lines 10-19), the storage medium having stored previously downloaded music data sets (downloaded, paragraph bridging pages 2 and 3);

a download device (PC 4) for downloading new music data sets to the storage medium (download to EEP-ROM, page 2, lines 5-9);

a reception device (table 3 with terminal) operatively coupled to the download device for receiving (fig. 4) music data sets transmitted from a source (download to EEP-ROM, page 2, lines 5-9).

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APA does not teach (1) that the each music data set includes type data for identifying content characteristics of the music data set, the type data being designable by a user, (2) a center station, which is the source of transmitted music data, (3) that at least one of the new music data sets include type data that does not match any of the type data of the previously downloaded music data sets.

As to (1)-(2), Tsurumi teaches a download system (fig. 1), wherein a set of music data (release file including music-piece file) includes type data for identifying content characteristics of the music data set (release number) and the type data is designable by a user (requirement transmitted from a terminal, col. 7, lines 46-52; editing at the host, col. 2, lines 52-62). Tsurumi also teaches a center station (host 1) is a source (download release files) of music data for a download device (terminal 3), wherein the music data includes type data (release file including release number). See col. 3, lines 16-42; col. 5, lines 7-18. As to (3), Tsurumi teaches that the new music data sets include type data that does not match any of the type data of the previously downloaded music data sets in that the latest release number included in a downloaded release file is the release number of the release file which is lastly downloaded from the host apparatus. In the following download, only the release file having the next release number is downloaded. (col. 5, lines 1-18; col. 7, line 56 – col. 8, line 6). In other words, the next release number of Tsurumi represents the type data (release number) that does not match any of the type data of the previously downloaded music data sets.

Therefore, it would have been obvious to use type data with the music data of APA and to include in the system of APA a center station that transmits music data having type data to the download device. It would also have been obvious that at least one of the new music data sets include type data that does not match any of the type data of the previously downloaded music data sets in APA. One of ordinary skill in the art would have been motivated to combine the teachings of APA and Tsurumi because this would have sped up the downloading process by storing/saving only necessary/timely information (col. 5, lines 7-18), which is desirable in APA (APA, page 3, lines 4-7).

Regarding claim 2, APA does not teach input device, data memory device and control device.

Tsurumi teaches the downloading system including
an input device for receiving inputs type data from the user of desired music data sets required the user (editing capability at the host to edit necessary information list, col. 5, lines 50-52);

a data memory device (storing unit 11) that stores the music data transmitted from the center station (col. 6, lines 47-50); and

a control device (control unit 10) for selecting at least one of the music data sets from the central station and storing in the data memory device (store release file in storing area 11 as specified by the necessary information file, col. 6, lines 43-59).

Therefore, it would have been obvious to include the input device, the data memory device and the control device into the system of APA as modified. Note discussion of claim 1 for a motivation to combine.

Regarding claim 3, APA as modified teaches (Tsurumi) the control device comprises:

a known type data read-in device (terminal, including means for editing) that reads in, as known type data, the type data of the music data sets previously downloaded and stored in the storage medium the player (release number of the release file lastly downloaded, col. 5, lines 1-18);

a desired type read-in device (terminal) that reads in, as desired type data, the type data input by the user using the input device (requirement/edited, col. 7, lines 49-52);

a new type data read-in device (communication control unit 12, control unit 10) that reads in, as new type data, the type data of the new music data sets received (downloaded release file) by the reception device (currently downloaded, col. 8, lines 1-6);

a determination device (control unit 10) that determines for each new data sets whether the new type data is equal to desired and different from all known type data (col. 6, lines 35-59; col. 7, line 52 – col. 8, line 6; fig. 4);

a data storing device (storing unit 11) for storing (store) the new music data sets transmitted from the center station in the data memory device when the new type data

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is equal to desired and different from all known type data (col. 6, lines 1-59; col. 7, line 52 – col. 8, line 6);

a downloading device (communication control unit 12) that downloads the music data stored in the data memory device by the data storage device to the storage medium of the portable player; and

a type data rewrite device (storing unit 11, control unit 10) that rewrites the new type data as known type data (update information, write newly released files to storage area, col. 6, lines 52-59). Note discussion of claim 1 for a motivation to combine.

Regarding claim 4, APA teaches the storage medium of the player comprises a writable ROM (EEP-ROM), and wherein the download device includes an encoding device that encodes music data into MPEG codes (MPEG encoder). See page 2, lines 5-10, 20-27.

Regarding claim 5, it is a method claim of claim 3 and thus note claim 3 for discussion.

Regarding claim 6, it is a program product claim of claim 5, and thus note claim 5 for discussion.

Regarding claims 7, 10, 12, APA teaches the player is a portable player (portable player, page 1, line 11).

Regarding claim 9, APA as modified teaches (Tsurumi) the download device comprises a receptor (communication control unit 12) which the player is coupled when music data is downloaded to the player.

Regarding claims 11, 13, APA teaches the player is placed on a table (table) when music data is downloaded to the player (page 1, line 27 – page 2, line 9). APA does not teach type data of music data stored in the storage medium provided in the player is read as known type data when the player is placed on the table. Tsurumi teaches type data of music data stored in the storage medium provided in the player is read as known type data (release number of the release file lastly downloaded, col. 5, lines 1-18). Therefore, it would have been obvious to read type data of music data stored in the storage medium provided in the player as known type data in APA. Note discussion of claim 1 of a motivation to combine. When the teachings are combined, it would have been obvious that such reading is performed when the player is placed on the table because this would have been the configuration that allows data I/O between the computer and the player.

Regarding claim 14, APA as modified teaches the type data is at least one of genre data, singer data and number data (Tsurumi, release number, col. 5, lines 7-18).

Regarding claim 15, APA teaches a recording apparatus comprising:

a player (portable player) carrying a storage medium (EEP-ROM) that stores sound data (store music data) (page 1, lines 10-19);

a recording device (PC 4) that records the sound data to the storage medium carried by the player (download to EEP-ROM, page 2, lines 5-9).

APA does not teach the sound data having type data which is capable of being designated by a user, reception device that receives the type data transmitted from a source, nor recording is performed when the type data transmitted from the source

matches the type data designated by the user and the sound data has not been recorded in the recording device.

Tsurumi teaches recording apparatus, wherein sound data (release file) has type data (release number) which is capable of being designated by a user (requirement/edited, col. 7, lines 49-52). Tsurumi teaches reception device (communication control unit 12) that receives the type data (release number) transmitted from a source (host) (col. 5, lines 1-52) and recording is performed when the type data transmitted from the source matches the type data designated by the user (release file having next or succeeding release number) and the sound data has not been recorded (not yet transmitted) (col. 6, lines 35-59).

Therefore, it would have been obvious to include type data, reception device into the system of APA, and to record when the type data transmitted from the source matches the type data designated by the user and the sound data has not been recorded. One of ordinary skill in the art would have been motivated to combine the teachings of APA and Tsurumi because this would have sped up the downloading process by storing/saving only necessary/timely information (col. 5, lines 7-18), which is desirable in APA (APA, page 3, lines 4-7).

Regarding claim 16, APA as modified teaches the type data is at least one of genre data, singer data and number data (Tsurumi, release number, col. 5, lines 7-18).

Regarding claim 17, APA teaches music data (music data, page 1, lines 11-19).

Regarding claim 19, APA teaches the player is an MP3 player (MP3 player, page 1, lines 11-19).

Regarding claim 20, APA as modified teaches (Tusrumi) the type data transmitted from the source is stored as new type data (update information, write newly released files to storage area, col. 6, lines 52-59) and is compared with the type data designated by the user (col. 7, line 49 – col. 8, line 6; col. 6, lines 52-59).

Regarding claim 21, APA as modified teaches (Tusrumi) teaches the type data transmitted from the source is stored as known type data (latest release number, col. 7, lines 25-26; col. 7, line 49 – col. 8, line 6).

Regarding claim 22, APA as modified teaches (Tusrumi) the sound data is recorded when the new type data (next release number) is identical to the type data designated by the user (release file having next release number and not yet transmitted) and the new data is different from the known type data (latest release number at terminal) (col. 6, lines 1-59).

Regarding claim 23, APA teaches an MPEG encoder and the sound data is encoded by the MPEG encoder (MPEG encoder, page 2, lines 5-10, 20-27).

Regarding claim 24, APA teaches the recording device includes a hard disk drive (HDD 9).

Regarding claim 25, APA teaches the sound data transmitted from the source is recorded in the hard disk drive and transferred to the storage medium (store in HDD and then download to ROM of player, page 2, lines 31-35).

10. Claims 8, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over author admitted prior art (page 1, line 10 - page 3, line 14, fig. 4, hereafter APA) in view

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of Tsurumi et al (US Pat. 5,890,910) as applied to claims 26 and 15 and further in view of Kim et al (U S Pat. 6,083,009).

Regarding claims 8, 18, APA as modified does not teach the center station is a radio station, nor that reception device is a tuner and the sound data is received through the tuner.

Kim teaches a recording apparatus (fig. 2), wherein a center station is a radio station (204, transmits radio data), and a reception device is a tuner (208a, 208e, 202) through which the music data sets are received (col. 5, lines 9-62).

Therefore, it would have been obvious to include and a tuner into the system of APA as modified. One of ordinary skill in the art would have been motivated to combine the teachings of APA as modified by Tsurumi with Kim because this would have allowed a user to listen to music in the fields (col. 2, lines 23-44).

Response to Arguments

11. Applicant's arguments filed 3-11-2004 have been considered but are moot in view of the new ground(s) of rejection. Applicant amended claims have added limitations not previously recited, thus, requiring a new grounds of rejection.

Applicant argued that "[n]either APA nor Tsurumi contain any disclosure of downloading to a player memory music data having type data, where the downloaded music data is desired by a user and is not already stored in a player memory. More specifically, neither reference speaks to using type data of a music data to determine

whether the music data is already stored in the player memory, and whether the music data is one desired by the user." (remarks, page 12, 2nd paragraph).

The examiner respectfully disagrees. Tsurumi teaches type data of music data as the release number contained in a music release file (col. 3, lines 16-42). Tsurumi uses such type data to determine whether the music data is already stored in the player memory in that the latest release number at a terminal represents music data is already stored therein. In Tsurumi, the music data desired by the user is represented by the release file having a next or succeeding release number. See col. 5, lines 1-33; col. 6, lines 35-59.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

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13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: (703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington.

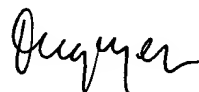
VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lao, Lun-See whose telephone number is (703) 305-2259. The examiner can normally be reached on Monday-Friday from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 whose telephone number is (703) 306-0377.

Lao, Lun-See
Patent Examiner
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DUC NGUYEN
PRIMARY EXAMINER